

Patent Docket: 1800/3  
Application Serial No. 10/087,204

### REMARKS

This amendment responds to the Office Action dated September 29, 2004. Claims 1-18 remain unchanged from the originally filed versions.

### **CLAIMS 8, 9, 17 AND 18 SATISFY 35 U.S.C. § 112, ¶ 1**

The Examiner rejected claims 8, 9, 17 and 18 under 35 U.S.C. § 112, ¶ 1 as failing to comply with the enablement requirement. With regard to the claims at issue, the Examiner contends that the claimed subject matter was not described in the specification in such a way as to enable one skilled in the art to which it pertains or with which it is most nearly connected to make and/or use the invention. More specifically, the Examiner contends the recitation in claim 8 and 17, from which claims 9 and 18 depend, "wherein the media includes a file stored on a memory device of the user's personal computer" is not enabled because "a skilled artisan would not know how to make and use the invention because the specification does not provide a clear and concise description of the manner and process of making a media file which is stored on the memory device of a user's personal computer."

The Applicant respectfully disagrees, as the recitation from the claims at issue does not require the user to make a media file, which is stored on the memory device of a user's personal computer, but rather to simply have a media file stored therein. Moreover, at paragraph [0028] of the specification of the present application, the applicant states:

The above explanation relates primarily to extracting raw parameter data from (physical) CDs inserted in a personal computer. In a similar fashion, one could extract raw parameters using the same process-flows as described from scanning a user's hard drive or tapping into streaming music. The associated metadata would come from either "file embedded info" (e.g., ID3 tags), or could be directly input by the user.

Therefore, the applicant respectfully submits that the claims at issue are enabled by the specification, and therefore request reconsideration and withdrawal of the rejection of claims 8, 9, 17 and 18.

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### CLAIMS 1-7 AND 10-16 ARE PATENTABLE OVER SHERF

The Examiner rejected claims 1-7 and 10-16 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,061,680 to Scherf [hereinafter "Scherf"]. Essentially, the Examiner contends that Scherf discloses all of the elements of the claims at issue. The Applicant respectfully disagrees with the Examiner's characterization of this reference vis-à-vis the claims at issue.

As further evidence of the lack of anticipation by Scherf of the claims at issue, Scherf is cited by the Applicant in the background section of the present application. See ¶ [0014]. Moreover, Scherf uses track length and numbers of tracks to uniquely identify a given compact disk – not a media sample – but rather a media with many complete tracks. In contrast, the present invention employs a media recognition system to identify a sample of a media (e.g., a portion of a song). To do so, the present invention utilizes a database of fingerprint/landmarks for each media against which the media sample is compared. To enable rapid creation of this database, the present invention utilizes third party playing of music to generate raw parameters, which are transmitted to a server and which are then processed into the necessary fingerprint/landmarks used in the recognition process. These raw parameters are not the same as the information used by Scherf, as the information used by Scherf cannot be further process to be used to identify a media sample. Simply put, the steps of "extracting a plurality of parameters from a media during a playing of the media" and "processing the plurality of parameters into a plurality of fingerprints/landmarks" as recited in claim 1, cannot be found in Scherf. The reason is that Scherf cannot be used in any recognition process to identify a media sample based on fingerprints/landmarks. As such, Scherf fails to anticipate or make obvious claims 1-7 and 10-16. Reconsideration and withdrawal of the rejection of claims 1-7 and 10-16 is therefore respectfully requested.

### CONCLUSION

The Applicants respectfully submit this application is in condition for allowance and request issuance of a Notice of Allowance.

Patent Docket: 1081/1  
Application Serial No. 10/113,782

In the event the prosecution of this application can be efficiently advanced by a phone discussion, it is requested that the undersigned attorney be called at (703) 435-9390.

### FEEES

If additional amounts are due following the amendments made to the claims above, or for any other reason, it is respectfully requested that the PTO charge any deficiency or credit any overpayment to the deposit account of Mayer Fortkort & Williams PC, Deposit Account, #50-1047.

Respectfully submitted,

By   
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Date: December 29, 2004

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#### Certificate of Facsimile Transmission

I hereby certify that this correspondence and any document referenced herein is being sent to the United States Patent and Trademark office via Facsimile to: 703-872-9306 on December 29, 2004.

Michael P. Fortkort  
(Printed Name of Person Sending Correspondence)

  
(Signature)